

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): Sidney Smith et al.
Appl. No.: 09/813,351
Conf. No.: 3473
Filed: March 19, 2001
Title: LARGE VOLUME FLEXIBLE CONTAINER
Art Unit: 3727
Examiner: Jes F. Pascua
Docket No.: CRTS-5679 (0112713-968)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Dear Sir:

I. INTRODUCTION

This Reply Brief is submitted in response to the Examiner's Answer mailed on December 11, 2006. The Reply Brief is directed, in part, to the new points of argument and arguments presented in the Examiner's Answer.

I. THE EXAMINER'S INTERPRETATION OF VALLOT IS IMPROPER

Appellants steadfastly disagree with and traverse the Examiner's interpretation of *Vallot*. It is a fundamental axiom of the patent law that a reference must be considered as a whole for what it reasonably discloses to those of ordinary skill in the art. *In re Wright*, 6 USPQ2d 1959 (Fed. Cir. 1988). Appellants respectfully submit that the Examiner has failed to follow this cornerstone of the patent law by picking and choosing isolated portions of *Vallot* in order to deprecate Appellants' claims. When *Vallot* is properly considered as a whole for what it reasonably discloses to those of ordinary skill in the art, *Vallot* fails to disclose or suggest two claim elements: 1) "an additional amount of material" permitting 2) the end panel "to extend outwardly...beyond the imaginary plane when the container is filled..." as recited in claim 17.

Vallot explicitly and unequivocally discloses a parallelepiped container. *Vallot* expressly and clearly defines the structure of the container as follows.

By definition, the “bottom face” and the “top face” of the sachet are the faces of the sachet such that the welds cross over these faces but are **parallel to each other** on the “lateral” faces of the sachet.

Vallot, col. 3 lines 12-15 (emphases added). Thus, by definition, the *Vallot* container is parallelepiped in shape and structure. Moreover, those of ordinary skill in the art recognize *Vallot*’s container as being a parallelepiped structure. See *Smith Affidavit* ¶ 7 (“*Vallot* discloses a parallelepiped container”); see also *Hurst Affidavit* ¶10 (“At most, *Vallot* discloses a flexible container having a 45° angle, that is parallelepiped in shape, with the top and bottom faces being parallel.”). When *Vallot* is properly considered as a whole, it is clear that *Vallot* discloses a parallelepiped-shaped container.

Similarly, by definition, the *Vallot* container cannot have an end panel that extends beyond the imaginary plane as does the claimed container. Such a distortion of the *Vallot* container would defy and contradict the structural definition of the *Vallot* container—namely, a parallelepiped container.

The Examiner has conveniently ignored *Vallot*’s express and unambiguous limitations regarding the structural aspects of the parallelepiped container. This is apparent by the Examiner’s assertion that the 30°-60° cut into the film used to make the *Vallot* container “inherently permits at least a portion of the top or bottom panel to extend outwardly...beyond an imaginary plane.” Examiner’s Answer at page 7. By definition, the *Vallot* parallelepiped container (*i.e.*, a container with a bottom face and a top face parallel to each other) cannot have an end panel that extends beyond the imaginary plane as does the claimed container. Extending *Vallot*’s top or bottom panel beyond the imaginary plane would result in the top face not being parallel to the bottom face. Such a permutation would produce a non-parallelepiped structure and would directly contradict the structural definition of the parallelepiped container clearly set forth in *Vallot*. Therefore, when *Vallot* is properly considered as a whole, *Vallot* fails to disclose or suggest two claim elements: 1) “an additional amount of material” permitting 2) the end panel “to extend outwardly...beyond the imaginary plane when the container is filled...” as recited in claim 17.

Moreover, *Vallot* is clear that the 30°-60° film cuts are process parameters applied to form the parallelepiped structure. In particular, *Vallot* discloses the following.

This parallelepiped shape can in particular be obtained by cutting the edges of the film at 30° to 60° and approximately 45° relative to the vertical axis of the sachet.

Vallot, col. 3 lines 12-15. Thus, the 30°-60° process parameter in no way alters the structural requirement of *Vallot*, namely the provision of a parallelepiped container. Rather, the 30°-60° cut into the film is used to create the parallelepiped structure for the *Vallot* container. Consequently, no motivation exists in *Vallot* to construct a container other than a parallelepiped container. The Examiner's disregard for 1) the explicit structural requirement that the *Vallot* container is a parallelepiped structure and 2) that *Vallot* discloses a parallelepiped container to those skilled in the art, is a clear indication that the Examiner is improperly using the Appellants' own application as a template to pick and choose among isolated portions of *Vallot* in order to reject Appellants' claims. This application of hindsight is improper as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Even assuming *arguendo* that *Vallot's* 30°-60° angle range suggests an end panel that extends beyond the imaginary plane (which it does not because the *Vallot* container, by definition, is a parallelepiped container), *Vallot* fails to disclose the claimed angle range of 135.01°-138° with sufficient specificity. The case law is clear that a claimed narrow range is not anticipated when a prior art reference fails to disclose the narrow range with sufficient specificity even though the prior art reference discloses a broad range encompassing the claimed narrow range. *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991 (Fed. Cir. 2006). The Examiner has admitted that *Vallot* provides no specific example of an angle in the claimed range of 135.01°-138°. Examiner's Answer, page 9. The Examiner has further acknowledged that the present case should be evaluated by the "case-by-case" standard as set forth in the sufficient specificity test of MPEP §2131.03. *Id.* The Examiner, however, has conveniently avoided the requisite "sufficient specificity" analysis as set forth in the *Atofina* case.

The Examiner states that the claim term "when the container is filled" is functional language and fails to differentiate the claimed container from *Vallot*. Examiner's Answer, p. 7. However, the case law is clear that a functional element of a claim must be considered just like

any other claim element for what it reasonably conveys to the skilled artisan. *Innova/Pure Water, Inc., v. Safari Water Filtration Systems, Inc.*, 381 F.3d 111 (Fed. Cir. 2004). Thus, when every word of the claim is properly considered, *Vallot* fails to disclose or suggest the claimed subject matter.

Appellants have established the criticality of the claimed angle range by showing that the range of 135.01°-138° achieves unexpected results. In particular, the claimed range of 135.01°-138° provides 1) wrinkle-free containers with 2) improved rupture resistance. *Smith Affidavit* ¶¶4-5, *Hurst Affidavit* ¶11. Appellants have further shown that *Vallot* fails to recognize the problems associated with rupture and wrinkling. *Hurst Affidavit*, ¶9. The Examiner states that since the Appellants were aware of the undesirable conditions of rupturing and wrinkling any skilled artisan would have been aware of the same conditions and could have conceived the claimed container with routine experimentation. Examiner's Answer, page 11. The Examiner's reasoning is circular and has no basis in the patent law. The Examiner's position that "if the inventor conceived the invention, then any skilled artisan could have created the invention" fails to follow the requirements of patentability as set forth in 35 U.S.C. §§ 101-103. Indeed, under the Examiner's reasoning, nothing would be patentable as any conception by an inventor could be readily performed by another person of ordinary skill in the art.

Appellants have proffered factual experimental data establishing that *Vallot* fails to recognize the problems related to rupture and wrinkling. *Hurst Affidavit*, ¶9. This is apparent as containers made with angles at the extremes of *Vallot's* angle range are unacceptable. *Hurst Affidavit*, ¶¶4-6. Accordingly, Appellants have established that *Vallot* only discloses a parallelepiped container with an angle of exactly 45°. *Hurst Affidavit*, ¶9-10. The Examiner contends that Appellants' evidence is lacking as Appellants' testing did not "discuss angles just outside the angle range of 135.01° at about 138°" Examiner's Answer pp. 11-12. Contrary to the Examiner's assertion, however, Appellants are not required to compare the claimed container with subject matter that does not exist in *Vallot*. *In re Geiger*, 815 F.2d 686 (Fed. Cir. 1986). As discussed in detail herein, *Vallot*, by definition, discloses a parallelepiped container with an angle of exactly 45°. The Appellants are not required to create prior art, nor to prove that their invention would have been obvious if the *Vallot* container were different than it actually was. *Id.* Accordingly, the evidence of nonobviousness the Appellants have presented

clearly establishes the criticality of the claimed angle range of 135.01°-138° by way of the unexpected results it provides.

The Examiner asserts that Appellants have failed to point out why the *Sasaki* container cannot have a volume of 200L. Examiner's Answer, page 12. As stated above, Appellants are not required to prove that the claimed subject matter is nonobvious over matter that is not disclosed in a prior art reference. *In re Geiger*, 815 F.2d 686 (Fed. Cir. 1986). *Sasaki* does not disclose 200L containers. To the contrary, *Sasaki* discloses containers with a volume of only 5-20L. *Sasaki*, col. 11 lines 44-47. The *Sasaki* container volume is an order of magnitude less than the claimed container volume of 200L. *Sasaki* fails to appreciate the problems associated with large volume containers. Smith Affidavit, ¶3. *Sasaki's* 5-20L container, an order of magnitude smaller than the claimed container, clearly teaches away from the claimed 200L container. The Appellants are not required to prove non-obviousness over a container volume that *Sasaki* does not disclose. *Id.*

Appellants respectfully submit that claims 2, 6-8, 12, 14-15, 17-19, 22, 28, 30, 31, and 52-56 are novel and non-obvious in view of *Vallot*. Appellants further submit that claims 29 and 51 are non-obvious in view of *Vallot* and *Sasaki*.

Respectfully submitted,

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